

REMARKS

In regard to the objection to claim 2, claim 2 has been amended above to clarify the claim.

Claims 1-6, 9-12 and 18-19 were rejected under 35 U.S.C. 102(b) as being anticipated by Boury (US 5,916,147). Claims 7-8 and 13-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boury (US 5,916,147) in view of Ogura et al. (US 6,639,213). Claims 15-17 were rejected under 35 U.S.C. 103(a) as being unpatentable over Boury (US 5,916,147) in view of Grabover et al. (US 5,938,588). The examiner is requested to reconsider these rejections.

The office action did not specify the grounds for rejecting claim 20 (added in the Article 19 amendment). The examiner is requested to clarify why claim 20 is being rejected.

Claim 1 claims that the first active deflection section is **limited** to deflection in a first plane and the second active deflection section is **limited** to deflection in a second different plane, and wherein the first plane is angled to the second plane. Column 8, lines 8-11 of Boury, referring to Fig. 2, states that "In reality, such a clear, precise demarcation is somewhat unlikely. In particular, the first curve 36A may curve upwardly somewhat along its length, deviating from the plane A, due to the tension on the control wire 34B." Thus, Boury explains that the first and second active deflection sections are not limited to first and second planes as claimed in claim 1. What is shown in Fig. 2 of Boury is inaccurate and, thus, fails to provide an "**enabling disclosure**" for a first active deflection section **limited** to

deflection in a first plane and a second active deflection section **limited** to deflection in a second different plane. Therefore, Boury should not be used as a disclosure of a first active deflection section **limited** to deflection in a first plane and a second active deflection section **limited** to deflection in a second different plane. This issue is addressed in **MPEP 2121**. Boury does not describe the claimed invention (a first active deflection section **limited** to deflection in a first plane and a second active deflection section **limited** to deflection in a second different plane) in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention. Thus, Boury does not provide an enabling disclosure and cannot be considered as anticipating claim 1. Boury clearly indicates that deflection of the first active deflection section is not "limited" to a first plane, but instead occurs in both a first plane and a second plane.

The features of claim 1 are not disclosed or suggested in the cited art. Therefore, claim 1 is patentable and should be allowed.

Though the claims dependent upon claim 1 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 1. However, to expedite prosecution at this time, no further comment will be made.

Claim 11 claims that the first and second active deflection sections are adapted to deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a

kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. There is no disclosure or suggestion in Boury that the catheter is adapted to deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole. The examiner is directed to MPEP §2173.05(g). A function limitation is an attempt to define something by what it does, rather than by what it is. There is nothing inherently wrong with defining some part of an invention in functional terms. A functional limitation **must be evaluated and considered**, just like any other limitation of the claim. In addition, the examiner is directed to MPEP section 2173.05(g) which discusses In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). In that case, in a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members **adapted to be positioned**" and "portions... being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present **structural attributes** of interrelated component parts of the claimed assembly.

In this case, the claim language "first and second active deflection sections are adapted to deflect such that a distal end of the nephroscope can be placed in a calyx of a lower pole of a kidney without the need to passively deflecting the front end of the shaft against tissue of the kidney of a patient to reach the calyx of the lower pole" must be

considered while evaluating patentability. There is no disclosure or suggestion of these structural and functional limitations in Boury. Thus, Boury does not "anticipate" claim 11.

Claim 11 also claims that the first and second active deflection sections are each limited to deflection in a single common plane relative to each other. There is no disclosure or suggestion in Boury of first and second active deflection sections are each limited to deflection in a single common plane relative to each other.

The features of claim 11 are not disclosed or suggested in the cited art. Therefore, claim 11 is patentable and should be allowed.

Though the claims dependent upon claim 11 contain their own allowable subject matter, these claims should at least be allowable due to their dependence from allowable claim 11. However, to expedite prosecution at this time, no further comment will be made.

Claim 18 is a method claim. Claim 18 claims a method of **viewing** an area inside a patient with an endoscope which includes repeating steps a) and b) for methodically **scanning** the area inside the patient by a series of adjacent parallel ones of the first paths. Boury is in regard to a catheter. There is no disclosure or suggestion of **viewing** an area inside a patient. Nor is there a disclosure or suggestion of repeating steps a) and b) in claim 18 for methodically **scanning** the area inside the patient by a series of adjacent parallel ones of the first paths. The features of claim 18

are not disclosed or suggested by Boury's catheter. Therefore, claim 18 is patentable and should be allowed.

Claim 19 claims that the first active deflection section is **limited to** deflection in a first plane and that the second active deflection section is **limited to** deflection in a second different plane. As noted above with respect to claim 1, Column 8, lines 8-11 of Boury, referring to Fig. 2, states that "In reality, such a clear, precise demarcation is somewhat unlikely. In particular, the first curve 36A may curve upwardly somewhat along its length, deviating from the plane A, due to the tension on the control wire 34B." Thus, Boury explains that the first and second active deflection sections are not limited to first and second planes as claimed in claim 1. What is shown in Fig. 2 of Boury is inaccurate and, thus, fails to provide an "**enabling disclosure**" for a first active deflection section **limited to** deflection in a first plane and a second active deflection section **limited to** deflection in a second different plane. Therefore, Boury should not be used as a disclosure of a first active deflection section **limited to** deflection in a first plane and a second active deflection section **limited to** deflection in a second different plane. Boury does not describe the claimed invention (a first active deflection section **limited to** deflection in a first plane and a second active deflection section **limited to** deflection in a second different plane) in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention. Thus, Boury does not provide an enabling disclosure and cannot be considered as anticipating claim 19. Boury clearly indicates that

deflection of the first active deflection section is not "limited" to a first plane, but instead occurs in both a first plane and a second plane.

Claim 19 also claims means for viewing an inside of a generally spherical shape through a fixed entrance into the generally spherical shape by an optical lens at the front end of the shaft without axially rotating the shaft. Boury merely discloses a catheter. There is no disclosure or suggestion of a means for viewing. There is no disclosure or suggestion of means for viewing an inside of a generally spherical shape through a fixed entrance into the generally spherical shape by an optical lens at the front end of the shaft without axially rotating the shaft.

The features of claim 19 are not disclosed or suggested in the cited art. Therefore, claim 19 is patentable and should be allowed.

Though the claim dependent upon claim 19 contain its own allowable subject matter, this claim should at least be allowable due to its dependence from allowable claim 19. However, to expedite prosecution at this time, no further comment will be made.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issue remain, the examiner is invited to call applicants' attorney at the telephone number indicated below.

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Respectfully submitted,

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